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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,929	01/15/2004	Bernd Simon	TRAUMA 3.0-452	6354

530 7590 02/27/2007  
LERNER, DAVID, LITTENBERG,  
KRUMHOLZ & MENTLIK  
600 SOUTH AVENUE WEST  
WESTFIELD, NJ 07090

EXAMINER
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SWIGER III, JAMES L

ART UNIT	PAPER NUMBER
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3733

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/27/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/757,929	SIMON ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	James L. Swiger	3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 10-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 15-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/10/2004</u>   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Election/Restrictions*

Applicant's election without traverse of Invention I, claims 1-9 and 15-18 in the reply filed on 1/8/2007 is acknowledged.

Claims 10-14 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 1/8/2007.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1-3, and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over List (DE 3800482 A1) in view of McGuire et al. (US Patent 5,374,270). List discloses a device for boring bone having an elongate shank (5), a boring portion at the front end (2) and a drive portion (end opposite, fig. 6) at the rear end of the shank. The device also has at least one window open to the bore (3). The window is also formed closest to the driving portion that also parallels the bore within the elongated shank.

List discloses the claimed device except for more specifically a bore that may fit a guide wire. McGuire et al. disclose a bore (17) that specifically may fit a guide wire that also follows the length longitudinally that allows for a guide portion (aka, a wire) to fit into it (see Col. 4, lines 26-39). It would have been obvious to one having ordinary skill

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in the art at the time the invention was made to construct the device of List having at least a more to specifically fit a guide wire in view of McGuire et al. to better guide the device to the required area.

Claims 4-6 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of List and McGuire et al. '270 as applied to claims 1 and 16, respectively above, and further in view of Ellis (US Patent 5,171,248). The combination of List and McGuire disclose the claimed invention except for diametrically opposed windows on the sides of the shank. Ellis disclose "diametrically opposed" 'windows' on the sides of the shank (24/26) that allow better viewing and access to the inner portion of the axial bore (see also Col. 2, lines 39-55). It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of the combination of List and McGuire having at least diametrically opposed windows in view of Ellis to have better access to the inside of the device.

Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of List and McGuire et al. and further in view of Jerger et al. (US Patent 6,264,661). The combination of List and McGuire et al. disclose the claimed invention except for, more specifically a guide wire. It is noted that the second end is capable of being connected to a power source for the drive if required. Jerger et al. disclose the use of a K-wire into the bone material as it would be installed in use of the device. See also Col. 2, lines 10-20. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of the combination of List

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and McGuire having at least a guide wire in view of Jerger et al. to better use the device and orient it for boring into bone.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of List and McGuire et al. and Jerger et al. as applied to claim 8 above, and further in view of Ellis. The combination of List and McGuire et al. and Jerger et al. disclose the claimed invention except for diametrically opposed windows. Ellis discloses "diametrically opposed" 'windows' on the sides of the shank (24/26) that allow better viewing and access to the inner portion of the axial bore (see also Col. 2, lines 39-55). It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of the combination of List and McGuire and Jerger et al. having at least diametrically opposed windows in view of Ellis to have better access to the inside of the device.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James L. Swiger whose telephone number is 571-272-5557. The examiner can normally be reached on Monday through Friday, 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



2/18/07

JLS



EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER